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10/784,485	02/20/2004	Michael L. Howard	2291.2.9.2	2179
21552 7590 07/20/2009 AUSTIN RAPP & HARDMAN 170 South Main Street, Suite 735 SALT LAKE CITY, UT 84101				
EXAMINER				
NGUYEN, TANH Q				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/784,485

**Applicant(s)**

HOWARD ET AL.

**Examiner**

TANH Q. NGUYEN

**Art Unit**

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 20 May 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/ISD)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "wherein the adapter sends the identification of the adapter to the provider computer without being requested to do so by the provider computer" in lines 14-16. Each of claims 8, 13, 15 also recites the same limitation. Applicant cites page 8, lines 17-18 of the disclosure and element 88 of FIG. 5 as support for the limitation. Page 8, lines 17-19 merely teaches "Identification for the communications adapter 20 and the type of electronic device 42 are provided 88 to the controller 32. The identification of the adapter 20 enables the controller 32 to send information or data to the adapter 20". Element 88 of FIG. 5 merely teaches "Provide communications adapter identification and electronic device/appliance identification to Controller". There is **no positive teaching** of "the adapter sending the identification of the adapter to the provider computer without being requested to do so by the provider computer" – hence the section and the element cited not being sufficient to support the limitation.

Claim 16 recites "wherein the adapter is unable to communicate with the electronic device without the new data sent by the provider computer, and wherein the new data allows the adapter allows the adapter to communicate with the electronic device" in lines 1-3. Applicant cites page 8, lines 24-26 of the disclosure as support for the limitation. Page 8, lines 24-26 merely teaches "appropriate computer program code to facilitate communication with the device 42. The computer program code that is sent to the adapter 20 from the controller 32 provides the functionality to communicate with, or more fully communicate with, the electronic device 42". There is **no positive teaching** of "the adapter being unable to communicate with the electronic device without the new data sent by the provider computer" – hence the section cited not being sufficient to support the limitation.

3. The rejections that follow are based on the examiner's best interpretation of the claims.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. (US 5,623,604) in view of Lieu et al. (US 6,708,045). Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Russell et al. in view of Lieu et al., and further in view of Cole et al. (US 6,074,434).

6. As per claim 1, Russell teaches a communications adapter [2, FIG. 1; FIG. 4] for facilitating electronic communications with an electronic device [4, FIG. 1] wherein the adapter is remotely reprogrammable by a provider computer [14, FIG. 1] through a communications network [6, FIG. 1], the adapter comprising:

a communications port [226, FIG. 4] for electronically connecting the adapter to the electronic device, wherein the adapter does not comprise a user interface with a display that is integrated as a part of the adapter;

communications hardware [202, 203, 204, 206, 208 – FIG. 4] for communicating automatically with the provider computer through the communications network;

a processor [216, FIG. 4]; and

memory [220, 222, 228, 230 – FIG. 4] programmed to cause the adapter to send an identification of the adapter to the provider computer via the communications

network [col. 33, lines 34-37; col. 35, lines 5-10; 232 – FIG. 4] and to receive new data sent by the provider computer via the communications network to update a program of the adapter [S36, FIG. 5C; S1619, FIG. 16B; FIG. 20; FIG. 24], wherein the new data comprises device instructions for the processor for communicating with the electronic device through the communications port [col. 1, line 61-col. 2, line 33], wherein the adapter is a handheld device that comprises a single-board computer [2, FIG. 3; FIG. 4; col. 10, lines 42-45].

Russell does not specifically teach the communications network being a wireless network. Lieu teaches wireless communications obviating the need for in-building wiring and cabling [col. 1, lines 15-28]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Russell's adapter in a wireless network environment because wireless communications obviate the need for in-building wiring and cabling – as suggested by Lieu.

7. As per claims 2-4, Lieu teaches the wireless network being a pager network, and the wireless network being cellular network [col. 1, lines 14-16]. Also, since it was known for cellular network and pager network to be global communications network for worldwide coverage [e.g. Lindgren (US 6,163,274) at col. 3, lines 46-48], it would have been obvious to one of ordinary skill in the art that for the wireless network to be a global communications network in order to be able to have world-wide communications.

8. As per claims 5-6, Russell teaches the new data comprising a translator that includes an object representation of the electronic device, a translator that includes a functional representation of the electronic device [the update program is a translator that

provides a new representation of the electronic device (altering program firmware: col. 1, lines 11-20)).

9. As per claim 7, Russell teaches the memory being programmed to cause the adapter to identify the electronic device and to further send an identification of the electronic device to the provider computer via the communications network [col. 8, lines 45-50].

10. As per claims 8-12, the claims generally correspond to claims 1-2, 5-7 with the electronic device having an external communications port [100, 102 - FIG. 3], and the new instructions being used for communications with the electronic device without altering any program code on the electronic device (no alteration necessary on the printer) - and are therefore rejected on the same bases. With respect to claims 10-11, note that the update program is a translator that provides a new representation of the electronic device (see rejections of claims 5-6 above), hence comprising services that reflect a function on the electronic device; or comprising functions that provide access to a function on the electronic device.

11. As per claims 13-14, the claims generally correspond to claims 1-2 with the adapter connected to an external communications port of the electronic device [100, 102 - FIG. 3], establishing communications with the provider computer [col. 2, lines 49-51] - and are therefore rejected on the same bases.

12. As per claim 15, see the rejections of claims 1, 8 above.

13. As per claim 16, Russell teaches the adapter being unable to communicate with the electronic device without the new data sent by the provider computer, and the new

data allowing the adapter to communicate with the electronic device [col. 1, line 61-col. 2, line 33].

14. As per claim 17, Russell teaches the memory comprising flash memory, and updating the program of the adapter comprising reprogramming the flash memory [222, FIG. 4; col. 9, lines 50; col. 11, lines 2-4; col. 13, lines 62-65].

15. As per claim 18, Russell teaches the communications adapter being reprogrammable for use with different types of electronic devices [col. 8, lines 25-29].

16. As per claim 19, Russell teaches the new data comprising a translator, wherein the translator is configured to send commands to the electronic device, access data on the electronic device, receive commands from the electronic device, control the electronic device, and translate messages to and from the electronic device [col. 7, lines 11-15; col. 8, lines 10-15; col. 8, lines 45-50; col. 9, lines 59-66; col. 10, lines 46-61; col. 12, lines 61-65].

17. As per claim 20, Russell teaches the translator (update program) being associated with the electronic device (see rejection of claims 1, 5-6 above).

Cole teaches a provider computer selecting a translator (an update program) associated with an electronic device from among multiple translators in a content server, and the content server comprising other translators that are not associated with the electronic device - in order to provide a translator that is consistent with the operation of the electronic device [col. 4, lines 36-39; col. 4, lines 41-46]. It is further known to store multiple files in a database to facilitate access to the multiple files, and it would have been obvious to store the multiple translators in the content server in a



database of the content server – in order to facilitate access to the multiple translators with the database.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the provider computer of Russell to select a translator (an update program) associated with the electronic device from among multiple translators in a translator database, wherein the translation database comprises other translators that are not associated with the electronic device – in order to provide a translator that is consistent with the operation of the adapter and the electronic device.

### ***Response to Arguments***

18. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TANH Q. NGUYEN whose telephone number is (571)272-4154. The examiner can normally be reached on M-F (9:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, TARIQ HAFIZ can be reached on (571)272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/TANH Q. NGUYEN/  
Primary Examiner, Art Unit 2182

TQN: July 17, 2009